REMARKS

The specification has been amended to include the serial number of a prior related application.

Claims 2, 3, 11, 15, 17, 18, 24, 25, 28, 29 and 33 have been amended, no claims have been canceled or added; as a result, claims 1-36 are now pending in this application. Claims 2, 3, 11, 15, 17, 18, 24, 25, 28, 29 and 33 were not amended in response to an art rejection. Claims 2, 3, 11, 15, 18, 24-25 and 28-29 were amended, by rewriting as independent claims, to obviate an objection. Claims 11, 17-18, 24-25 and 33 were amended to correct grammar used in the claims.

In the Office Action Summary, checkbox 6 lists claim 7 as being rejected, while checkbox 7 lists claims 2-12 (which includes claim 7) as being objected to. Because no other reference was made in the Office action regarding a basis for rejecting claim 7, the applicant has treated claim 7 as if it is objected to, and not as if claim 7 was rejected.

In the Notice of References Cited, Reference B and F appear to be the same reference, namely Kossatchev *et al.* (U.S.-6,698,012). Further, page 4 of the Office action states that "Method and system for testing behavior of procedures, US 6698012 B1" is prior art not relied upon, yet the examiner has rejected claims 1, 13-14, 17 and 27 as being unpatentable under 35 U.S.C. § 103(a) over Halviatti *el al.*, which is patent number US 6,698,012 B1. Applicant respectfully requests clarification and correction of these matters.

Objection to the Drawings

The Office Action Summary states that the drawings filed "07 June 2001" are objected to. No explanation is given in the Office action for the objection. This application was filed on August 7, 2001. The applicant believes that formal drawings (11 sheets) for this application were submitted on September 27, 2001. Because the applicant is unsure of which set of drawings are being objected to and for what reason(s), no changes to the drawings have been made. Should objection to the drawings of the pending application be maintained, applicant respectfully requests guidance as to what is believed to be the objectionable subject matter in the drawings.

§*103 Rejection of the Claims*

Claims 1, 17, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Halviatti *et al.* (U.S. 5,475,843) in view of Kossatchev *et al.* (U.S. 6,698,012). Applicant does not admit that Kossatchev *et al.* is prior art and reserves the right to "swear behind" Kossatchev *et al.* as provided for under 37 C.F.R. § 1.131. Applicant respectfully traverses the rejections of claims 1, 17 and 27.

Claim 1 recites, "a software built-in self-test engine (SBE) based on the user directives, the instruction information and device constraints, for subsequent storage on-board of a complex device under test (DUT)." (emphasis added) Claim 17 recites, "a software built-in self-test engine (SBE) based on the user directives, the instruction information and device constraints, for subsequent storage on-board of a complex device under test (DUT)." (emphasis added) Claim 27 recites, "a software built-in self-test engine (SBE) based on the user directives, the instruction information and device constraints, for subsequent storage on-board of a complex device under test (DUT)." (emphasis added) The applicant respectfully submits that neither Halviatti *et al.* nor Kossatchev *et al.*, either alone or in combination, teach or suggest, "for subsequent storage on-board of a complex device under test (DUT)." The Office action asserts on page 3 that Halviatti *et* al. discloses "for subsequent storage of a device under test and activation of a functional test on the device under test (col 41, lines 45-50, col 34, lines 17-27, col 31, lines 24-55, col 21 lines 40-45), where 'in-memory testing models (of the application under test)' is the on-board complex device under test as claimed." However, applicants' representative has read these cited portions of Halviatti *et al.* and respectfully submits that phrases "subsequent storage on-board" or a "complex device under test (DUT)" do not appear in the cited references.

In addition, the examiner's assertion that "in-memory testing models (of the application under test) is the on-board complex device under test as claimed" is not supported by the record. In Figure 6 of Halviatti *et al.*, testing model of application 655 is clearly show as a separate component from the application under test 665, the two being coupled through Windows API 670 and test port 650. Thus, the examiner's assertion that the in-memory testing models is *on-board* the complex device under test is contradicted by Figure 6. Hence, Halviatti *et al.* fails to teach or disclose all of the elements recited in claims 1, 17 and 27. Thus, the Office action fails to state a *prima facie* case of obviousness with respect to claims 1, 17 and 27. Therefore, the

applicant requests withdrawal of the rejections and reconsideration and allowance of claims 1, 17 and 27.

Claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Halviatti *et al.*, further in view of Kossatchev *et al.* and official notice. Applicant respectfully traverses the rejections of claims 13 and 14.

Claim 13 recites "a microprocessor." The Office action on page 3 states that the examiner is taking official notice of a microprocessor. Applicant respectfully objects to the taking of official notice, and pursuant to M.P.E.P. § 2144.03, applicant traverses the assertion of official notice and requests that the examiner cite a reference that teaches the missing elements. If the examiner cannot cite a reference that teaches the missing elements, applicant respectfully requests that the examiner provide an affidavit describing how the missing elements are present in the prior art. If the examiner cannot cite a reference or provide an affidavit, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 13.

Claim 14 recites "storage in the on-board memory." The Office action on page 3 states that the examiner is taking official notice of storing in the memory. Applicant respectfully objects to the taking of official notice, and pursuant to M.P.E.P. § 2144.03, applicant traverses the assertion of official notice and requests that the examiner cite a reference that teaches the missing elements. If the examiner cannot cite a reference that teaches the missing elements, applicant respectfully requests that the examiner provide an affidavit describing how the missing elements are present in the prior art. If the examiner cannot cite a reference or provide an affidavit, applicant requests withdrawal of the rejection and reconsideration and allowance of claim 14.

Allowable Subject Matter

Claims 2-12, 15-16, 18-26, and 28-36 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 2, 3, 11, 15, 18, 24, 25, 28 and 29 have been rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claim 4 is dependent on rewritten claim 3, so claim 4 includes all the limitations of rewritten claim 3. Claim 4 has not been rewritten in independent

form. Claims 5-10 are dependent on rewritten claim 2, so claims 5-10 include all the limitations of rewritten claim 2. Claims 5-10 have not been rewritten in independent form. Claim 12 is dependent on rewritten claim 11, so claim 12 includes all the limitations of rewritten claim 11. Claim 12 has not been rewritten in independent form. Claim16 is dependent on rewritten claim 15, so claim 16 includes all the limitations of rewritten claim 15. Claim 16 has not been rewritten in independent form. Claims 19-23 are dependent on rewritten claim 18, so claims 19-23 include all the limitations of rewritten claim 18. Claims 19-23 have not been rewritten in independent form. Claim 26 is dependent on rewritten claim 25, so claim 26 includes all the limitations of rewritten claim 25. Claim 26 has not been rewritten in independent form. Claim 30 is dependent on rewritten claim 29, so claim 30 includes all the limitations of rewritten claim 29. Claim 30 has not been rewritten in independent form. Claims 31-36 are dependent on rewritten claim 28, so claims 31-36 include all the limitations of rewritten claim 28. Claims 31-36 have not been rewritten in independent form. Applicant respectfully submits that claims 2-12, 15-16, 18-26, and 28-36 are in a form that obviates the objections. Therefore, applicant respectfully requests reconsideration and allowance of claims 2-12, 15-16, 18-26, and 28-36.

Pertinent Subject Matter

The references cited as pertinent but not relied upon by the Office action are not part of the rejections in the Office action, so applicant need not respond to the assertion of pertinence. Applicant is expressly not admitting to this assertion of pertinence and reserves the right to address the assertion should it be included in a future rejection.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The examiner is invited to telephone applicant's attorney at 612-371-2109 to facilitate prosecution of the above identified patent application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

PRAVEEN K. PARVATHALA ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
Attorneys for Intel Corporation
P.O. Box 2938
Minneapolis, Minnesota 55402
(612) 371-2109

Date September 27, 2004   By Danny J. Padys
                              Reg. No. 35,635

CERTIFICATE UNDER 37 C.F.R. § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 27 day of September, 2004.

KACIA LEE

Name

Kacia Lee

Signature